APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,857	11/16/2000	William L. Jansen	44439.1.8.1	5894

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EXAMINER
MYHRE, JAMES W

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____3____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Sep 29, 2003* _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-25* _____ is/are pending in the application.

    4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-25* _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some* c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other:

DETAILED ACTION

Response to Arguments

1.   The Amendment/Request for Reconsideration filed on September 29, 2003 is sufficient to

overcome the <u>Chien et al</u> (US2001/54003) reference.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use
> or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-3, 6-17, 19, and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated

by <u>Biorge et al</u> (5,806,045).

        Claim 1: <u>Biorge</u> discloses a method for tracking and converting loyalty points, comprising:

                a. Obtaining the number of award points awarded to a user under at least one

loyalty program (col 7, lines 14-36);

                b. Converting the user's award points into a credit (col 7, lines 14-36);

                c. Providing access to a retailer that provides discounts based on the credit (col 7,

lines 4-36);

d. Calculating the discount off the price of a selected product or service offered by the retailer (col 7, lines 4-36); and

e. Applying the discount to the price of the product or service purchased by the user (col 7, lines 4-36).

The cited passage in Biorge discloses retrieving the number of accrued incentive points (award points) from the customer's account, converting at least some of the points to a discounted amount according to the desires of the customer, and applying the discounted amount to the purchase transaction.

Claim 2: Biorge discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses obtaining information about the loyalty program prior to obtaining the award points (col 7, lines 4-13).

Claim 3: Biorge discloses a method for tracking and converting loyalty points as in Claim 2 above, and further discloses that the information is obtained from the user through an interactive communication (col 5, lines 5-8).

Claim 6: Biorge discloses a method for tracking and converting loyalty points as in Claim 3 above, and further discloses converting points from a plurality of loyalty programs (col 4, lines 30-46 and col 7, lines 4-36).

Claim 7: Biorge discloses a method for tracking and converting loyalty points as in Claim 6 above, and further discloses using the payment information to complete the purchase (col 7, lines 4-36).

Claim 8: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses updating the user's credit balance after the purchase of the product or service (col 7, lines 51-64).

Claim 9: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 8 above, and further discloses storing the award points in a computerized database (col 7, lines 51-64).

Claim 10: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 9 above, and further discloses that the loyalty program database is on a remote server (col 7, lines 51-64).

Claim 11: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 10 above, and further discloses using computer-to-computer communication to retrieve the number of award points (col 7, lines 4-36).

Claim 12: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 11 above, and further discloses the computer-to-computer communication is a database query (col 7, lines 4-36).

Claim 13: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 12 above, and further discloses that the database query is submitted as a batch communication to the remote server (col 7, lines 51-64).

Claim 14: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses displaying the current status of the user's credits to the user (col 13, lines 4-7).

Claim 15: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses updating the award points (col 7, lines 51-64).

Claim 16: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 15 above, and further discloses updating the award points as a batch communication with the remote server (col 7, lines 51-64).

Claim 17: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 16 above, and further discloses verifying the award points (col 7, lines 4-36).

Claim 19: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses obtaining payment information regarding the user (col 14, lines 61-63).

Claim 22: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses converting the award points into a proportionate number of system-wide credits (col 1, lines 38-46 and col 4, lines 42-46).

Claim 23: <u>Biorge</u> discloses a system for tracking and converting loyalty points,

comprising:

      a. A database for maintaining credit balances of a user (col 7, lines 51-64);

      b. An interactive communication link to a loyalty program to which the user has

subscribed (col 5, lines 5-8);

      c. An interactive communication link to at least one vendor of a product or service

(col 7, lines 4-36); and

      d. Computerized means for reducing the credit balance approximately

proportional to a discount offered by the vendor (col 7, lines 4-36).

Claim 24: <u>Biorge</u> discloses a system for tracking and converting loyalty points as in Claim

23 above, and further discloses linking to a plurality of loyalty programs (col 7, lines 4-36).

Claim 25: <u>Biorge</u> discloses a system for tracking and converting loyalty points as in Claim

23 above, and further discloses linking to a plurality of products or services that the user may

purchase (col 7, lines 4-36).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 4, 5, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Biorge et al (5,806,045) in view of Eggleston et al (6,061,660).

Claims 4, 5, and 21: Biorge discloses a method for tracking and converting loyalty points

as in Claim 3 above, but does not explicitly disclose that the interactive communication is

executed over a TCP/IP connection, nor implemented using HTML and CGI scripts. However,

Eggleston discloses a similar system and method for tracking and converting loyalty points that

also discloses that the interactions may take place over the Internet using HTML and CGI scripts

(col 7, lines 22-26 and col 10, lines 10-42). The Examiner notes that TCP/IP was developed for

the Unix system, but has become the defacto standard transmission protocol used on networks,

such as the Internet. Therefore, it would have been obvious to one having ordinary skill in the art

at the time the invention was made to use HTML and CGI scripts during the communication and

to use the TCP/IP protocol for the communication. One would have been motivated to use these

standard formats in view that these are the standard communication protocols used on the

Internet.

Claim 20: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim

1 above, and further discloses verifying the identity of the customer using a user code (col 5, lines

5-8). This implies that the user has registered with the system in order to receive the user code;

however, it is not explicitly disclosed that the user registers on-line. However, <u>Eggleston</u>

discloses a similar system and method for tracking and converting loyalty points and also discloses

the users registering online (col 12, lines 25-36). Therefore, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to allow the customers in

<u>Biorge</u> to complete an online registration form. One would have been motivated to include online

registration in <u>Biorge</u> in order to allow immediate registration and use of the loyalty program by a

customer.

6.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Biorge et al</u>

(5,806,045) in view of <u>Storey</u> (5,774,870).

Claim 18: <u>Biorge</u> discloses a method for tracking and converting loyalty points as in Claim

1 above, and further discloses that the transaction may be performed on-line or off-line (col 3,

lines 56-58). However, it is not explicitly disclosed providing information about products or

services for sale to the user via communication with the retailer. <u>Storey</u> discloses a similar system

and method for tracking and converting loyalty points that also discloses providing information

about products or services for sale to the user on a personalized "Product Homepage" (col 4,

lines 27-58). The user may then select one or more products and indicate that he would like at

least a portion of accrued loyalty points applied towards the purchase price. Therefore, it would

have been obvious to one having ordinary skill in the art to provide the user in <u>Biorge</u> with

information about products or services for sale by the retailer. One would have been motivated to

provide this information to the user in order to allow the user to redeem the loyalty points during

a future transaction as discussed by <u>Biorge</u>.
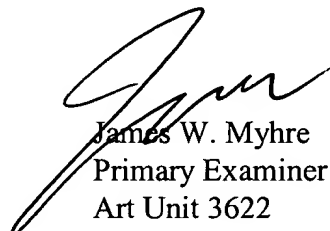
Conclusion

7.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The

examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal

or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes may be

submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

JWM
December 15, 2003

James W. Myhre
Primary Examiner
Art Unit 3622